

B 38. (New) The cigarette package of claim 34, wherein the channel comprises a guide portion and an extinguishing portion.

A² 39. (New) The cigarette package of claim 34, wherein the cigarette saver is constructed from plastic.

40. (New) The cigarette package of claim 34, wherein the cigarette saver is constructed from metal.

41. (New) The cigarette package of claim 34, wherein the end of the channel that terminates in the cigarette saver is tapered.

REMARKS

The following remarks are submitted to address the issues raised in the Office Action mailed May 24, 2002.

Claims 26-41 are currently pending in the application, claims 1-25 having been cancelled and new claims 26-41 having been added by the foregoing amended. Claims 1-2, 4-6, 18, and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,321,757 to McCutcheon (hereinafter "McCutcheon"). Claims 1-9 and 12-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 6-70740. Claims 10 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 6-70740 or McCutcheon in view of U.S. Patent No. 4,886,076 to Gilbert et al. (hereinafter "Gilbert").

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Applicant has submitted herewith a Supplemental Information Disclosure Statement attaching one patent. Applicant respectfully requests consideration of the cited document and making the same of record in the prosecution of this application.

The rejection of claims 1-2, 4-6, 18, and 20-22 under 35 USC 103(a) as being unpatentable over McCutcheon is respectfully traversed.

McCutcheon relates to a cigarette pack and ash holder/extinguisher for neatly keeping cigarettes and their ashes in a container.¹ The cigarette pack and ash holder/extinguisher includes a container having one compartment adapted to receive and store a pack of cigarettes and a second compartment adapted to receive and store cigarette ashes and spent cigarettes.² A tubular member is securely disposed in the second compartment and is adapted to extinguish a cigarette.³ First and second lid members are hingedly attached to the container.⁴

In the cigarette pack and ash holder/extinguisher of McCutcheon, a user can insert a pack of cigarettes in the first compartment, and as the user smokes and uses a cigarette, the user can extinguish the cigarette by putting the burning end of the cigarette into the tubular member

¹ See McCutcheon, Abstract.

² See *id.*, col. 1, l. 66 to col. 2, l. 3.

³ See *id.*, col. 2, ll. 4-6.

⁴ See *id.*, col. 2, ll. 6-7.

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which snuffs out the cigarette.⁵ The user can put ashes in the second compartment while smoking the cigarette and can also throw the spent cigarette into the second compartment.⁶

Applicant has cancelled claims 1-2, 4-6, 18, and 20-22 without prejudice to, or disclaimer of, the subject matter therein. In order to advance prosecution of this application, Applicant has not separately set forth arguments for the patentability of the canceled claims over the references cited. Nonetheless, Applicant contends that these claims are patentable over McCutcheon.

Applicant has added new claims 26-41. New claims 26-41 do not include any new matter, and support can be found, among other places, at pages 1, 7, and 10-12 of the specification, in the figures, and in the claims as originally filed.

New independent claim 26 is directed to a cigarette package that comprises a paperboard crush proof box designed to hold twenty-five cigarettes, twenty cigarettes, and a cigarette saver positioned inside the paperboard crush proof box and comprising two end portions, the distance between the two end portions forming a length of the cigarette saver. The first end portion of the cigarette saver includes an opening to a channel that terminates in the cigarette saver.

New independent claim 34 is directed to a cigarette package that comprises a paperboard crush proof box designed to hold twenty-three cigarettes, twenty cigarettes, and a cigarette saver positioned inside the paperboard crush proof box and comprising two end portions, the distance between the two end portions forming a length of the cigarette saver. The first end portion includes an opening to a channel that terminates in the cigarette saver.

The present invention advantageously utilizes a paperboard crush proof box designed to hold more than twenty cigarettes. Twenty cigarettes are arranged in the crush proof box (e.g., in a 7-6-7 arrangement as shown in the figures) with the extra space in the crush proof box

⁵ See *id.*, col. 4, ll. 57-61.

⁶ See *id.*, col. 4, ll. 61-65.

providing adequate room for the cigarette saver. For example, with a crush-proof box designed to hold twenty-five cigarettes, but actually only including twenty cigarettes, the cigarette saver occupies the space provided for five additional cigarettes. In this regard, the present invention advantageously allows a cigarette manufacturer to sell a normal number of cigarettes in a package that resembles a conventional cigarette package, but also includes a cigarette saver.⁷

McCutcheon fails to teach or suggest a cigarette package that comprises a paperboard crush proof box designed to hold twenty-five cigarettes (or twenty-three cigarettes), twenty cigarettes, and a cigarette saver comprising two end portions, the distance between the two end portions forming a length of the cigarette saver. The cigarette pack and ash holder/extinguisher of McCutcheon is a container that appears to be designed for re-use by a consumer in that the user inserts a pack of cigarettes in a first of two compartments in the container.⁸ In contrast, the cigarette package of the present invention is a "pack" in that a consumer would purchase the cigarette package containing twenty cigarettes and a cigarette saver.

In addition, while McCutcheon does not disclose the material from which its container is constructed, Applicant respectfully submits that the container would not likely be paperboard, as claimed in the present invention, due to the means for fastening the first and second lid members to the container that includes boss members attached to the front wall and latch members attached to the lid members.⁹

For at least the reason that McCutcheon does not teach or suggest a cigarette package that comprises a paperboard crush proof box designed to hold twenty-five cigarettes (or twenty-three cigarettes), twenty cigarettes, and a cigarette saver comprising two end portions and a channel as

⁷ See Spec., p. 2.

⁸ See McCutcheon, col. 4, ll. 57-58.

⁹ See *id.*, col. 4, ll. 26-43.

claimed in claims 26 and 34, Applicant respectfully submits that claims 26 and 33 are patentable over McCutcheon. As claims 27-33 and 35-41 depend from these independent claims, Applicant likewise respectfully submits that these claims are also patentable. For all of the foregoing reasons, claims 26-41 are not taught or suggested by McCutcheon and the Examiner is respectfully requested to withdraw the rejection.

Claims 1-9 and 12-25 - 35 U.S.C. § 103(a)

The rejection of claims 1-9 and 12-25 under 35 USC § 103(a) as being unpatentable over JP 6-70740 is respectfully traversed.

JP 6-70740 relates to a tobacco case capable of directly putting out a cigarette using a fire extinguishing cylinder.¹⁰ The tobacco case of JP 6-70740 includes "a detachable bottom lid" and "[t]he interior of the tobacco housing part 13 is divided so as to enable the insertion of the plural cigarettes 15 before use or the put out cigarettes [sic] one by one."¹¹

Applicant has cancelled claims 1-9 and 12-25 without prejudice to, or disclaimer of, the subject matter therein. In order to advance prosecution of this application, Applicant has not separately set forth arguments for the patentability of the canceled claims over the references cited. Nonetheless, Applicant contends that these claims are patentable over JP 6-70740.

Because Applicant does not have an English translation of JP 6-70740, the following arguments are based on the English Abstract and Constitution and the Figures. JP 6-70740 fails to teach or suggest a cigarette package that comprises a paperboard crush proof box designed to hold twenty-five cigarettes (or twenty-three cigarettes), twenty cigarettes, and a cigarette saver comprising two end portions, the distance between the two end portions forming a length of the

¹⁰ See JP 6-70740, English Abstract.

¹¹ See JP 6-70740, English Constitution.

cigarette saver. For example, JP 6-70740 does not teach or suggest a paperboard crush proof box designed to hold twenty-five (or twenty-three) cigarettes as the tobacco case of JP 6-70740 utilizes a housing part 13 for housing plural cigarettes and includes a detachable bottom lid 20. A housing part 13 designed to house twenty cigarettes would appear to require more space than is required to hold twenty cigarettes without a housing part. Further, Applicant submits that the tobacco case of JP 6-70740 would not likely be constructed from paperboard as it would be difficult to construct a paperboard crush proof box with a detachable bottom lid. As noted above, one of the advantages of the present invention is that it allows a cigarette manufacturer to sell a normal number of cigarettes in a package that resembles a conventional cigarette package, but also includes a cigarette saver.¹²

For at least the reason that JP 6-70740 does not teach or suggest a cigarette package that comprises a paperboard crush proof box designed to hold twenty-five cigarettes (or twenty-three cigarettes), twenty cigarettes, and a cigarette saver comprising two end portions and a channel as claimed in claims 26 and 34, Applicant respectfully submits that claims 26 and 34 are patentable over JP 6-70740. As claims 27-33 and 35-41 depend from these independent claims, Applicant likewise respectfully submits that these claims are also patentable. For all of the foregoing reasons, claims 26-41 are not taught or suggested by JP 6-70740 and the Examiner is respectfully requested to withdraw the rejection.

Claims 10 and 11 - 35 U.S.C. § 103(a)

The rejection of claims 10 and 11 under 35 USC 103(a) as being unpatentable over JP 6-70740 or McCutcheon in view of Gilbert is respectfully traversed.

¹² See Spec., p. 2.

Gilbert relates to a cigarette snuffer having a tapered opening and a closed bottom so as to progressively squeeze the lighted end of a cigarette and extinguish it without destroying the cigarette ash.

Applicant has cancelled claims 10 and 11 without prejudice to, or disclaimer of, the subject matter therein. In order to advance prosecution of this application, Applicant has not separately set forth arguments for the patentability of the canceled claims over the references cited. Nonetheless, Applicant contends that these claims are patentable over JP 6-70740 or McCutcheon in view of Gilbert.

The Examiner cites Gilbert as "disclos[ing] a cigarette snuffer and teach[ing] that such a snuffer can be formed of a molded material or metal."¹³ Applicant's claims that are directed to a cigarette saver being constructed from plastic or metal¹⁴ are dependent claims. For the reasons set forth above, Applicant respectfully submits that independent claims 26 and 34 are patentable over McCutcheon and JP 6-70740. Because claims 31-32 and 39-40 depend from these independent claims, Applicant respectfully submits that these claims are also patentable.

¹³ Office Action, mailed May 24, 2002, p. 3.

¹⁴ Claims 31-32 and 39-40.

Amendments in the Claims:

In accordance with 37 CFR § 1.121(c), the following replacement claims show all the changes made by the foregoing amendments relative to the previous version of the claims. Material added is shown in underlined text, material deleted is shown in [brackets].

Claims 1-25 have been cancelled without prejudice to, or disclaimer of, the subject matter therein.

New claims 26-41 have been added.

26. (New) A cigarette package comprising:
a paperboard crush proof box designed to hold twenty-five cigarettes;
twenty cigarettes; and
a cigarette saver positioned inside the paperboard crush proof box and comprising two end portions, the distance between the two end portions forming a length of the cigarette saver, wherein the first end portion includes an opening to a channel that terminates in the cigarette saver.

27. (New) The cigarette package of claim 26, wherein the opening is elliptical for receiving cigarettes into the channel.

28. (New) The cigarette package of claim 26, wherein the opening is round.

29. (New) The cigarette package of claim 26, wherein the width of the opening is greater than the diameter of one of the cigarettes.
30. (New) The cigarette package of claim 26, wherein the channel comprises a guide portion and an extinguishing portion.
31. (New) The cigarette package of claim 26, wherein the cigarette saver is constructed from plastic.
32. (New) The cigarette package of claim 26, wherein the cigarette saver is constructed from metal.
33. (New) The cigarette package of claim 26, wherein the end of the channel that terminates in the cigarette saver is tapered.
34. (New) A cigarette package comprising:
a paperboard crush proof box designed to hold twenty-three cigarettes;
twenty cigarettes; and
a cigarette saver positioned inside the paperboard crush proof box and comprising two end portions, the distance between the two end portions forming a length of the cigarette saver, wherein the first end portion includes an opening to a channel that terminates in the cigarette saver.

35. (New) The cigarette package of claim 34, wherein the opening is elliptical for receiving cigarettes into the channel..
36. (New) The cigarette package of claim 34, wherein the opening is round.
37. (New) The cigarette package of claim 34, wherein the width of the opening is greater than the diameter of one of the cigarettes.
38. (New) The cigarette package of claim 34, wherein the channel comprises a guide portion and an extinguishing portion.
39. (New) The cigarette package of claim 34, wherein the cigarette saver is constructed from plastic.
40. (New) The cigarette package of claim 34, wherein the cigarette saver is constructed from metal.
41. (New) The cigarette package of claim 34, wherein the end of the channel that terminates in the cigarette saver is tapered.

CONCLUSION

For the foregoing reasons, a favorable Office Action is respectfully solicited. The Examiner is respectfully invited to contact J. Jason Link at 336.607.7443 or Charles W. Calkins at 336.607.7315 to discuss any matter relating to this application.

Respectfully submitted,

Date: _____

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